REMARKS

Claims 1-43 are active and pending within the application, all of which stand rejected. In response, Applicant has amended claims 37 -39 and has provided remarks urging reconsideration and withdrawal of the rejection of all claims.

35 U.S.C. §101

Claims 37-39 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In response, Applicant has amended these claims to recite a "computer readable signal bearing medium." As amended, the claims now provide the structural interrelationships that permit the program's configuration to be actualized in a computer readable medium and, therefore, the claims are directed to a statutory class of subject matter. Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. §101 of claims 37-39.

35 U.S.C. §102

Claims 1, 9, 12, 24, 29, 30, 37, and 38 stand rejected under 35 U.S.C. §102 as anticipated by Peterman (US pat. No. 6,480,838). Applicant respectfully disagrees with the Examiner's interpretation of what Peterman discloses and urges that Peterman does not identically disclose every limitation of these claims.

Claim 1 recites scanning a plurality of documents for variants of a linguistic term and then tracking the occurrences of the variants to determine an acceptable usage of

the linguistic term. Even though Peterman uses the word "variant" within his disclosure, the inquiry does not end there as to whether Peterman identically discloses the subject matter being claimed. If Peterman intends a different meaning for the term "variant" than the meaning within the present claims, then Peterman does not identically disclose the claimed subject matter.

In Peterman, a corpus of documents has been created using OCR. When a user wants to form a query to search the documents, Peterman's device identifies variant spellings of the query keywords that are likely to be the result of an OCR error (see column 4, lines 8-11 and lines 35-42). The query is then expanded to include these alternatives when the search is executed. In Peterman, variants are errors that occur because of OCR processing.

According to the present invention, variants of a linguistic term are alternative usages of a term that is unrelated to OCR or other errors. This difference in meaning is highlighted later in the claim where the occurrences of the variants are tracked to determine acceptable usage of the linguistic term. Peterman does not identically disclose determining an acceptable usage of the linguistic term, as recited in the claim. Thus, Peterman does not identically disclose each and every feature recited in claim 1 and, therefore, does not provide the factual basis to support a rejection of claim 1 under 35 U.S.C. §102. Applicant respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102 of claim 1 and its dependent claims 9 and 12.

Similar to claim 1, claims 24 and 37 also recite determining an acceptable usage of a linguistic term. Accordingly, for the same reasons provided above, Applicant urges that Peterman does not identically disclose all the features recited in these claims and, therefore, requests withdrawal of the rejection under 35 U.S.C. §102 of claims 24, 37 and their respective dependent claims 29, 30 and 38.

35 U.S.C. §103

Claims 2-8, 10, 13, 14, 16-18, 20, 25-29, 31-33 and 35 stand rejected under 35 U.S.C. 103 as unpatentable over Peterman in view of Anick et al. (US Pat. No. 6,519,586). The Examiner asserts that Peterman discloses the subject matter substantially as claimed but relies on Anick et al. for disclosure of the specific limitations within the dependent claims.

Anick et al. disclose that new concepts are often expressed as concatenations of existing terms instead of new, single words. Anick et al. locate facets of a particular search term through lexical dispersion that measures the number of different words with which that particular word co-occurs within such syntactic contexts. The more different words that are identified, the more likely that the search term will represent a useful conceptual category relevant to the query. (see column 2, lines 40-55).

Thus, the "facets" of Anick et al. are not variants of a linguistic term. Instead, they are "key informational concepts" that can be identified within a document based

on a query search term. Anick et al. do not scan documents for <u>variants of a linguistic</u>

<u>term</u> nor <u>determine acceptable usage of the linguistic term</u>, as recited in claim 1.

Thus, when considered singly or in combination, neither Peterman nor Anick et al.

disclose or suggest all the elements recited in claim 1. One of the critical foundations

for establishing a prima facie case of obviousness under 35 U.S.C. 103 is to identify

in one or more references a teaching or suggestion of each and every limitation recited

in the claim. Applicant urges that this burden has not been discharged as the

references do not teach scanning documents for <u>variants</u> of a linguistic term (as meant

by the claim) nor determining <u>acceptable usage of a linguistic term</u>. Accordingly,

Applicant respectfully requests reconsideration and withdrawal of the rejection under

35 U.S.C. 103 of claim 1 and its dependent claims 2-8, 10, 13, 14, 16 - 18, and 20.

Similar to claim 1, claim 24 recites determining <u>an acceptable usage of a</u>

<u>linguistic term</u>; therefore, for at least the reasons provided above, withdrawal of the

rejection under 35 U.S.C. 103 of claims 25-29, 31-33 and 35, which depend from

claim 24, is respectfully requested.

Claim 11 stands rejected under 35 U.S.C. 103 as being unpatentable over

Peterman in view of Sundaresan et al. (US Pat. No. 6,385,629). Claims 19, 21, 22,

34 and 36 stand rejected under 35 U.S.C. 103 as being unpatentable over Peterman

and Anick et al. in view of Mueller (US Pat. No. 6,694,484). Claims 40-43 stand

rejected under 35 U.S.C. 103 as unpatentable over Mueller in view of Anick et al.

Claim 11 stands rejected under 35 U.S.C. 103 as unpatentable over Anick et al. in

view of Sundaresan. Claims 19, 21, 22, 34 and 36 stand rejected under 35 U.S.C.

103 as unpatentable over Anick et al. in view of Mueller.

Under 35 U.S.C. §103(c), with respect to applications filed on or after

November 29, 1999, a reference is disqualified as prior art if two conditions are met:

(1) the reference is qualified as prior art only under 35 U.S.C. §102(e), (f), or (g), and

(2) the reference is commonly owned with the claimed invention (or subject to an

obligation to be assigned to the same entity) at the time the invention was made. In

this instance, Sundaresan et al. and Mueller are available as prior art only under 35

U.S.C. §102(e) due to their respective issue dates (May 7, 2002 and Feb. 17, 2004)

which are after the filing date of the present application (December 29, 2000).

Applicant asserts that the claimed invention and the Mueller and Sundaresan

references were commonly owned (or subject to an obligation to assign to)

International Business Machines Corporation. As evidence of this common ownership,

an assignment for the instant application is recorded at Reel/Frame 011418/0810-

0812 of the USPTO Assignment Branch, while an assignment for the Sundaresan et

al. reference is recorded at Reel/Frame 010398/0711 and an assignment for the

Mueller reference is recorded at Reel/Frame 008599/0486. Applicants urge that both

Sundaresan et al. and Mueller are unavailable as prior art to establish a *prima facie*

case of obviousness under 35 U.S.C. §103(a). Accordingly, Applicants respectfully

request reconsideration and withdrawal of the rejections under 35 U.S.C. §103 of

claims 11, 19, 21, 22, 24, 36, and 40-43.

Claim 15 stands rejected under 35 U.S.C. as unpatentable over Peterman and Anick et al. in view of Komissarchik et al. (US Pat. No. 5,799,276). The Examiner asserts that Komissarchik discloses "that a single phonetic transcription of a word in a dictionary can be replaced with a plurality of phonetic transactions of phonetically permissible variants of the word." The Examiner concludes that one of ordinary skill would have been motivated to combine the references because "Komissarchik teaches that it is possible to replace a word in a dictionary".

For the reasons stated above, Applicants urge that Peterman and Anick et al., either singly or in combination, do not disclose every feature of claim 1 from which claim 15 depends. Accordingly, Peterman and Anick et al. do not provide the factual basis for establishing a prima facie case of obviousness under 35 U.S.C. §103 with respect to claim 15. In addition, Komissarchik relates to speech recognition and accounting for variations that are permissible in clear speech. As part of this processing, the dictionary used by the Hidden-Markov Models to determine what likely was spoken includes phonetic variations. Applicants urge, however, that the mere identification that it is possible to have phonetic variants in a speech recognition system is not a well-reasoned explanation of why one of ordinary skill would be impelled to modify either Peterman or Anick et al. as is required to establish a prima facie case of obviousness under 35 U.S.C. §103. Applicant respectfully urges that the Examiner has not provided a cogent explanation of why one of ordinary skill would have been motivated to modify

either Peterman or Anick et al. to include phonetic variants. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103 of claim 15 are respectfully requested.

Claims 23 and 39 stand rejected under 35 U.S.C. §103 as unpatentable over Anick et al. The Examiner asserts that Anick et al. teach the subject matter of claim 23 substantially as claimed but does not disclose that browsing and tracking occur concurrently. The Examiner concludes it would have been obvious to include concurrency "to preserve the consistence of data on the web page." Applicant is unsure about this rationale as web pages are dynamically updated in many instances and concerns for consistency would appear to be minor if not non-existent. Similar to remarks provided above, Anick et al. relates to locating "facets" in a corpus of documents. For example, if you search for "cooking", then the documents that contain that term are analyzed to locate other words (e.g., cheese) that co-occur with cooking. These co-occurrence statistics are used to determine facets from which a user can select to further refine the search. Anick et al. is unrelated to locating variants of a linguistic term, as recited in claim 23. Anick et al. do not teach or suggest tracking relative occurrences of a plurality of variants of a linguistic term nor do they teach or suggest determining an acceptable usage of the linguistic term.

Accordingly, Anick et al. do not teach or suggest every limitation recited in claim 23 and, therefore, do not provide the necessary basis to establish a prima facie case of obviousness under 35 U.S.C. §103. Reconsideration and withdrawal of the rejection of claim 23 are respectfully requested.

Claim 39 is summarily dismissed by the Examiner as "a program product of method claim 23". Applicants respectfully disagree. Claim 39 recites that the computer-readable signal bearing medium include a document having a tag that identifies the acceptable variant of a linguistic term and a definition of the linguistic term. Anick et al. do not teach or suggest a document that includes a definition of the linguistic term. Accordingly, Anick et al. do not teach or suggest every limitation recited in claim 39 and do not provide the necessary basis to establish a prima facie case of obviousness under 35 U.S.C. §103. Reconsideration and withdrawal of the rejection of claim 39 are respectfully requested.

Claims 1-10, 12-18, 20, 23-33, 35, and 37-39 stand rejected under 35 U.S.C. §103 as unpatentable over Anick et al. The Examiner asserts that Anick et al. disclose the subject matter substantially as claimed but admits that Anick et al. do not use the phrase "scanning a plurality of documents". The Examiner concludes that it would have been obvious to do so.

Similar to the remarks provided above, Applicant urges that the "facets" of Anick et al. are unrelated to "variants of a linguistic term" as recited in the claims. The facets of Anick et al. involve identifying relations between a search term and

co-occurring words. The purpose of identifying this relationship is to define different contexts in which the search term might be used. The recited "variants of a linguistic term" relate to variations of that term, not to co-occurring words. The purpose of identifying the variants in the claims is to determine acceptable usage of the linguistic term, not to identify contextual domains for that linguistic term. Applicants strongly urge that Anick et al. simply do not teach nor suggest any functionality that involves variants of a linguistic term and specifically not functionality related to the acceptable use, or the acceptable definition, of a linguistic term as recited in the claims.

Accordingly Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. §103 of claims 1-10, 12-18, 20, 23-33, 35, and 37-39.

Claim 15 stands rejected under 35 U.S.C. §103 as unpatentable over Anick et al. in view of Komissarchik et al. The Examiner asserts that Komissarchik discloses "that a single phonetic transcription of a word in a dictionary can be replaced with a plurality of phonetic transactions of phonetically permissible variants of the word." The Examiner concludes that one of ordinary skill would have been motivated to combine the references because "Komissarchik teaches that it is possible to replace a word in a dictionary".

For the reasons stated above, Applicants urge that Anick et al., either singly or in combination with another reference, do not disclose every feature of claim 1 from which claim 15 depends. Accordingly, Anick et al. do not provide the factual

basis for establishing a prima facie case of obviousness under 35 U.S.C. §103 with respect to claim 15. In addition, Komissarchik relates to speech recognition and accounting for variations that are permissible in clear speech. As part of this processing, the dictionary used by the Hidden-Markov Models to determine what was likely spoken includes phonetic variations. Applicants urge that the mere identification that it is possible to have phonetic variants in a speech recognition system is not a well-reasoned explanation of why one of ordinary skill would be impelled to modify Anick et al. as is required to establish a prima facie case of obviousness under 35 U.S.C. §103. Applicant respectfully urges that the Examiner has not provided a cogent explanation of why one of ordinary skill would have been motivated to modify Anick et al. to include phonetic variants. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103 of claim 15 are respectfully requested.
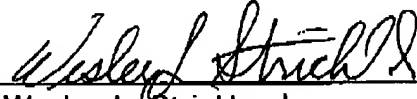

CONCLUSION

In view of the above remarks and amendments, Applicant believes that claims 1-43 as amended are in condition for allowance and passage of this case to issue is respectfully requested. No fees are believed due in connection with this submission, however, if any additional fees are required, the Commissioner is authorized to charge same or credit any overpayment to our Deposit Account No.

23-3000. The Examiner is invited to contact the undersigned attorney if there are

any questions or additional concerns with regard to this response.

Respectfully submitted,

WOOD, HERRON & EVANS

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